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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,311	05/30/2001	David Blight	035451-0131 (3640.Palm)	7636

26371 7590 12/15/2006

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EXAMINER
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PHU, SANH D

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/870,311	<b>Applicant(s)</b> BLIGHT ET AL.	
	<b>Examiner</b> Sanh D. Phu	<b>Art Unit</b> 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is responsive to the Applicant's Response and Declaration Under 37 C.F.R. 1.131, filed on 10/19/06. Accordingly, claims 1-26 are currently pending.

### *Oath/Declaration*

2. The Declaration under 37 C.F.R. 1.131, filed on 10/19/06 under 37 CFR 1.131 has been considered but is ineffective to overcome Hamaguchi et al (2002/0010617), previously-cited, because of following reasons:

-The declarant did not submit evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);

(G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on.

–The declarant submitted documents “Exhibit A”, “Exhibit B” and “Exhibit C” as documentary evidence of conception. However, it is deemed that they are insufficient to prove that the invention was completed prior to the effective date of Hamaguchi et al. Document “Exhibit A” and “Exhibit C” does not provide any information to prove that the invention was completed prior to the effective date of Hamaguchi et al. Document “Exhibit C” does not provide information to prove who is/are the inventor(s) of the concept being disclosed in the document and when the concept being disclosed in the document was completed. It is found only on section 3, page 2 of document “Exhibit B”, the date of a conception (11.02.2000) at a location of a conception (Santa Clara). However, such a general allegation for proving that the invention was completed prior to the date of Hamaguchi et al is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm’r Pat. 1883). Note that the affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the

particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).

Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

- The declarant did not provide evidence or proof of reduction to practice of the invention in this country or a NAFTA or WTO member country before the effective date of Hamaguchi et al.

- The declarant did not provide evidence or proof of reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of Hamaguchi et al.

- The declarant did not provide evidence to establish diligence from a date

Art Unit: 2618

prior to the date of a subsequent reduction to practice or to the filing of application.

Therefore, the examiner contends that Hamaguchi et al is a proper prior art against the present application.

*Claim Rejections – 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-7 and 9-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamaguchi et al (2002/0010617), previously-cited.

-Regarding to claim 1, see figures 1, 2A-2D, 3A, 3B and 6, and sections [0018]-[0039], Hamaguchi et al discloses a system comprising:

a portable electronic device (11)(see figure 1) including a RF transceiver (see [0024]); and

a database program (inherently included) running on the portable electronic device, the database program configured to store a history of wireless station information (e.g., registered retail store ID, retail store name, etc.,) and available resource information (e.g., business category, message information, icon location, and/or icon information, etc.) (see figures 3A, 3B and [0025]–[0026]);

the wireless station information being representative of wireless stations coming in communications with the RF transceiver as the portable electronic device is being moved through an environment (see [0034]–[0038], and

the available resource information being correlated with the wireless station information (see figures 3A and 3B, and [0038]–[0039]) and the available resource information being distinct from and representative of wireless resources available through the wireless stations (105,...,121, 123)(see figure 6, and [0033]), wherein the wireless resources are point counts and associated services of providing the point counts (see [0020, 0023, 0032, 0046–0050]. (Note that term “resource” can be understood here as an accessible supply that can be withdrawn from when necessary).

–Regarding to claim 2, Hamaguchi et al discloses that the portable electronic device is a handheld computer (see [0024]).

–Regarding to claims 3 and 4, Hamaguchi et al discloses that RF transceiver is a transceiver (see [0024]).

–Regarding to claims 6 and 7, Hamaguchi et al discloses that the wireless station information includes the address of the wireless station (see [0026]).

–Regarding to claims 9 and 10, Hamaguchi et al discloses that the resource information includes a resource identifier/description (e.g., business category (see [0026])).

– Regarding to claim 11, Hamaguchi et al discloses that the resource information includes keywords (e.g., retail store name) relating to the resource (see [0026]).

– Regarding to claim 12, Hamaguchi et al discloses that the resource information includes attributes (icon information, icon location) for an object oriented data description (see [0026]).



–Regarding to claim 13, Hamaguchi et al discloses that the resource information includes a listing of associated wireless stations (105...121, 123) (see figure 6).

–Regarding to claim 14, see figures 1, 2A–2D, 3A, 3B and 6, and sections [0018]–[0039], Hamaguchi et al discloses a method comprising:

step (see [0034]) of roaming within an environment with a portable electronic device (11) (see figure 1) having a Rf transceiver;

step of scanning for wireless enabled device(s) within range of the RF transceiver of the portable device by receiving possible signal(s) from said wireless enabled device(s)(see [0034]).

step of storing wireless station information relating to the wireless enabled device(s) in a database (see figure 3B);

step of storing, in the data base, available resource information (e.g., business category, message information, icon location, icon information, etc.) (see figure 3B) distinct from and relating to the resources, wherein the wireless resources are products and/or services for sale (see [0020]), point counts and associated services of providing the point counts (see [0020, 0023, 0032,

0046-0050]], which are coupled to and available through a wireless station (comprising a “store”, and devices (9, 5, 1, 3) (see figure 1, and [0018]), and step of accessing, on the portable electronic device, the data base including the wireless station information and the available resource information (see [0038, 0039].

-Regarding to claim 15, Hamaguchi et al discloses step of querying the database for a specified resource (see [0034]-[0045]).

-Regarding to claim 16, Hamaguchi et al discloses step of performing a keyword search (retail store ID) of the database (see [0034]).

-Regarding to claim 17, Hamaguchi et al discloses step of providing location information (icon location, icon information) relating to accessing the specified resource {see figure 3B).

-Regarding to claim 18, Hamaguchi et al discloses that location information includes a set of directions (icon location, icon information) (see figure 3B).

-Regarding to claim 19, Hamaguchi et al discloses that location information includes a map (see figure 6).

Art Unit: 2618

–Regarding to claim 20, Regarding to claim 14, see figures 1, 2A–2D, 3A, 3B and 6, and sections [0018]–[0039], Hamaguchi et al discloses a method comprising:

step (see [0034]) of moving through an environment with a portable electronic device (11) (see figure 1) having a RF transceiver;

step (see [0035]) of receiving information (e.g., business category, message information, icon location, icon information, etc.) distinct from and relating to wirelessly accessible resources, wherein the wireless resources are point counts and associated services of providing the point counts (see [0020, 0023, 0032, 0046–0050], which are coupled to and available through a wireless station (comprising a “store”, and devices (9, 5, 1, 3) (see figure 1, and [0018]));

step (see [0035]) of storing the information in a database on the device;  
and

step (see [0034]–[0035]) of accessing the database information according to a specific query.

–Regarding to claims 21–26, Hamaguchi et al discloses that the environment is a geographical area (see figure 6).

*Claim Rejections – 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi et al.

–Regarding to claim 5, Hamaguchi et al does not disclose whether the wireless station information includes the type of wireless transceiver being used by the wireless station. However, since the wireless station information may include necessary information concerning about the wireless station, to make the wireless station information more informative (see [0026]) It would have been obvious for a person skilled in the art, when building or carrying out Hamaguchi et al, upon his design preference and within his skills, to add information about the type of wireless transceiver being used by the wireless

station, e.g., the operating frequency of the wireless transceiver, to the wireless station information, without affecting the overall system performance.

–Regarding to claim 8, Hamaguchi et al does not disclose that the wireless station information includes a timestamp representative of a time that the portable device was in range of the wireless station. However, recording times of events for a provide of information is well known in art. For instance, Hamaguchi et al teaches recording/storing in a data base (DB 97) times of events (date of purchase) (see section [0023]). Hamaguchi et al also teaches that entry data can be easily added in a database for making the database more informative (see [0025]. It would have been obvious for a person skilled in the art, when carrying out Hamaguchi et al, to record or add information in the registered retail store dB of the portable device about the a time “timestamp” indicating when the portable device was in range of the wireless station for a certain communication (registration, transaction, etc.), or other necessary information related to the certain communication, to the wireless station information in order to make the wireless station information record stored in the registered retail store dB more informative, as taught by Hamaguchi et al.

*Response to Arguments*

7. Applicant's arguments filed on 10/19/06 have been fully considered but they are not persuasive. The applicant mainly argues that Hamaguchi et al is not a proper prior art by a submission of Declaration Under 37 C.F.R. 1.131, filed on 10/19/06. However, the Declaration is deemed ineffective to overcome Hamaguchi et al because of reasons set forth above in this Office Action. Therefore, the previous rejections are maintained and repeated.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In

Art Unit: 2618

no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D. Phu whose telephone number is (571)272-7857. The examiner can normally be reached on M-Th from 7:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner  
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SP



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